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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No.

THE O. M. SCOTT AND SONS COMPANY, *Petitioner,*

v.

CLYDE M. NOLL AND S. JOSEPH FORTUNATO,
as Trustees, *Respondents.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Petitioner prays that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Sixth Circuit in this cause.

OPINIONS BELOW

The opinion of the Court of Appeals sought to be reviewed here appears in the appendix to this petition on pages 1a-15a. It is reported at —— F.2d ——, 175 USPQ 392. The dissenting opinion appears at pages 15a-17a. The opinion of the District Court, reversed in part by the Court of Appeals, is reported at 169 USPQ 336, F. Supp. ——. Pertinent excerpts appear in the appendix at pages 19a-25a.

JURISDICTION

The opinion and judgment of the Court of Appeals was entered September 27, 1972. Timely petition for rehearing was denied by order dated November 17, 1972 (App. 18a). Jurisdiction for Writ of Certiorari is invoked under 27 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Does the Patent Act of 1952 change the rule of Graver Tank & Mfg. Co. v. *Linde Air Products, 336 U.S. 271 (1949) that a patent claim embracing unpatentable or inoperative subject matter is invalid and will not be resuscitated by judicial restatement to cover only embodiments disclosed in the patent specification?*

The Courts of Appeals, in answering this question, are in direct conflict.

This question has been answered in the affirmative by the Sixth Circuit Court of Appeals in the decision for which review is here sought and the Ninth Circuit Court of Appeals in *Kockum Industries, Inc.* v. *Salem Equipment, Inc.*, 175 USPQ 81 (9th Cir. 1972). A petition for Writ of Certiorari to review the decision in *Kockum Industries, Inc.*, was filed January 2, 1973, and assigned No. 72-951.

This question has been answered in the negative by the Court of Appeals for the District of Columbia in *Siegel* v. *Watson*, 267 F.2d 621 (D.C. Cir. 1959), by the Court of Appeals for the Fourth Circuit in *Wilcox Mfg. Co.* v. *Eastern Gas and Fuel Associates*, 400 F.2d 960 (4th Cir. 1968) (cert. den. 393 U.S. 1051), and by the Court of Customs and Patent Appeals in *Lundberg, Application of*, 244 F.2d 543 (CCPA 1957).

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The conflict raises the fundamental issue of the proper role of patent claims in the patent system and poses a direct challenge to this Court's repeated pronouncements that:

"Patent claims measure the patent grant."

2. If the monopoly defined by a patent claim may be given limited scope to avoid invalidity, may it then be given a broad scope when asserted against the public?

The Sixth Circuit Court of Appeals in its decision here and the Court of Appeals for the Third Circuit in *Devex* v. *General Motors Corp.*, —— F.2d ——, 175 USPQ 321 (3rd Cir. 1972) have answered the question in the affirmative, in direct opposition to this Court's long-standing rule against such result. *White* v. *Dunbar*, 119 U.S. 47, 51 (1886).

We understand a Petition for Writ of Certiorari to review the decision in *Devex* will be filed.

3. Where, through an integrated set of private agreements, two competitors (licensees under a patent) are given the power to control all matters affecting exploitation and enforcement of the patent under which they are licensed, is proof of the exercise of the power necessary to establish patent misuse?

The Court of Appeals below said "yes."

STATUTORY PROVISIONS

Section 112 of the Patent Act of 1952 (35 U.S.C. § 112) provides:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person

skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The substance of the first two paragraphs has been a part of the Patent Statutes for over one hundred years. The third paragraph is new with the Patent Act of 1952.

STATEMENT OF THE CASE AS TO QUESTION 1.

In The District Court

Respondents' Patent 2,678,265 here in issue claims, as a method, the use of any one of a specifically defined, enormously large group of unpatented chemical compounds (only one of which had been tested by the inventor (App. 25a)) for the control of crabgrass in a weed-infested lawn.

The validity of the claim in issue was challenged by petitioner on the ground that it overclaimed the asserted invention. The District Court sustained this challenge and found, on evidence accepted by the Sixth Circuit Court of Appeals, that (App. 25a):

"Herein plaintiff has laid claim to a group of compounds containing thousands or even hundreds

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> of thousands of members but the inventor had tested only one such compound at the time of his patent application.
>
> * * *
>
> Plaintiff offered no proof or theory of the effectiveness of all of the thousands of compounds covered by the '265 patent. Therefore at the present time there is some scientific evidence as to the effectiveness of far less than one percent of the compounds claimed."

The District Court also found, on evidence accepted by the Court of Appeals, that compounds within the claims of the patent in suit were not effective for the purposes of the invention, i.e., were inoperative (App. 25a).

Based on this factual record the Trial Court held that the patent claim in issue was invalid for overclaiming (App. 25a), a result required by *Graver, infra.* The Trial Court followed an unbroken line of Sixth Circuit precedents, including *Kalle* v. *Multazo Co.,* 109 F.2d 321 (6th Cir. 1940), which restated the prohibition of *Corona* v. *Doran,* 276 U.S. 358, 385 (1928) against claiming inoperative subject matter.

The issue of the effect of the Patent Act of 1952 on the overclaiming rule was not raised in the Trial Court. Apparently counsel and the Trial Court shared the prevailing view of the patent bar that it had none.

The Trial Court found the patent infringed if valid.

In The Court Of Appeals

The Sixth Circuit recognized that the claim in issue was invalid under the rule enunciated in *Graver,* commenting (App. 6a):

> "It is often stated that the claims define the invention and that limitations in the specification

> will not be incorporated into unambiguous claims to uphold their validity (citing *Graver* v. *Linde*) ... the present case is indistinguishable from *Graver.*"

However, the court held the claim valid, based upon its view that the third paragraph of § 112 of the Patent Act of 1952 had changed the law and exempted functional combination "means" claims from the rule of *Graver,* and *Corona* (which had been characterized as the *Kalle* rule of the Sixth Circuit), stating (App. 8a):

> "We are of the view that this statutory amendment [35 U.S.C. § 112, par. 3] modified the *Kalle* rule as to claims falling within its scope. Claim 2 in the present case is such a claim, in that it is for a combination and the function of the element ... is specified ..."

The Court accordingly imparted validity to the claim, which had been found to cover the use of thousands of compounds (some inoperative, most of unknown efficacy) by limiting the claim to the handful of compounds disclosed in the patent specification (which it assumed, without proof, were operative) and to the equivalents of those compounds (App. 8a, 9a).

The theory that § 112 exempted the claim from the *Graver* rule was first injected into the case by the Court of Appeals, acting *sua sponte,* weeks after the oral argument.

As stated by Judge McAllister in dissent (App. 16a):

> "The above section of the statute was never thought of by plaintiff-appellants as being a ground for reversal of the District Court's holding of invalidity. It was never considered in their brief on appeal; and it was only after the case was argued and our Court asked for their views on this

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heretofore unmentioned question that appellants, for the first time, relied on the third paragraph of 35 U.S.C. A. Sec. § 112 for reversal of the judgment of the District Court."

THE CASES IN ACCORD AND IN CONFLICT WITH THE SIXTH CIRCUIT

The Ninth Circuit Court of Appeals in *Kockum Industries, Inc., supra,* decided August 14, 1972 invoked § 112 of the Patent Act of 1952 to revalidate a claim held invalid by the District Court on the ground of indefiniteness and overclaiming to include prior art. The Ninth Circuit expressly recognized that the claims did "not meet the requirements [for definite differentiation from the prior art] of *Gen. Electric Co.* v. *Wabash Co.,* 304 U.S. 364, 369." (175 USPQ 81, 83)

The Court nevertheless held that 35 U.S.C. § 112, third paragraph, permitted restatement of the claims to incorporate features disclosed in the specification and that "construing the claims in question as so limited by the specifications, invalidity under *Gen. Electric Co.* v. *Wabash Co., supra,* is avoided." (175 USPQ 81, 83). The Court also expressly recognized that its "ruling results in a restating of the claims."

In direct opposition to the view of the Sixth and Ninth Circuits, the Courts of Appeals for the Fourth Circuit, the District of Columbia and the Court of Customs and Patent Appeals have held that § 112, third paragraph, does not authorize the limitation of combination "means" claims by reference to the patent specifications.

In *Wilcox Mfg. Co., supra,* p. 2, the Fourth Circuit Court of Appeals specifically held that the rule of *Graver, supra,* survived the passage of the 1952 Patent

Act intact. After holding patent claims invalid under the rule of *Graver,* the court stated:

> "Attempting to rescue the patent, Wilcox would consider as within the claims so much of the specification as employ reciprocation in describing the machine."

The court rejected this position and stated:

> "Nor can this attempt be justified under 35 U.S.C. § 112, which allows the use of the term 'means' as it appears in the Wilcox claims, to bring into the claims of the combination patent any element described in the specification." (400 F.2d 960, at 963)

The Court of Appeals for the District of Columbia also squarely rejected the view of the Sixth and Ninth Circuit Courts of Appeals, stating in *Siegel, supra,* p. 2:

> "Appellant believes that when reading the claims one must incorporate the specification in determining whether or not to grant the patent. He relies on the third paragraph of 35 U.S.C. 112 (1952). Appellee counters, and we agree, that the claims of an application are the correct measure; limitations not expressed in the claims, though disclosed in the specifications, are not read into the claims." (267 F.2d 621 at 623)

The Court of Customs and Patent Appeals in *Lundberg, supra,* p. 2, after reviewing the history of the prior decisional law which resulted in the adoption of the third paragraph of § 112, concluded:

> "We are of the opinion, therefore, that, notwithstanding the third paragraph of Section 112, it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the applicant regards as his invention, without limitations imported from the speci-

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> fication, whether such language is couched in terms of means plus function or consists of a detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim." (244 F.2d 543 at 548)

All of these cases, holding that § 112, paragraph 3, did not authorize limitation of unambiguous patent claims by reference to the specification, were called to the Sixth Circuit Court's attention. Thus, the conflict between the Sixth Circuit and the other circuits in their interpretation of § 112 was deliberate. The conflict between the circuits will continue until resolved by this Court.

STATEMENT OF THE CASE AS TO QUESTION 2

To save the claim from invalidity, the Sixth Circuit limited the claim in issue to the "corresponding structure, material or acts" described in the specification and equivalents thereof (App. 8a). Yet, when petitioner on the misuse issue urged that the respondents unlawfully extended the scope of the claim and charged royalties for the use of compounds clearly outside the scope of the claim, the Court said (App. 14a):

> "... the claimed subject matter of the Schwerdle patent is not limited to the specifically disclosed embodiments thereof. Broad claims may include subject matter not so embraced."

A similar result was reached by the Third Circuit Court of Appeals in *Derex* v. *General Motors Corp., supra.* There, as here, the patent claim, invalid on its face, had been construed in limited fashion to impart validity. Nevertheless the Court permitted the patentee to assert the same claim broadly to establish infringement.

STATEMENT OF THE CASE AS TO QUESTION 3

(Patent Misuse)

Prior to the instant action the patent in suit was placed in trust (App. 3a) by two groups, referred to as Vineland and Cleary, competitors in the sale of unpatented compounds, principally disodium methyl arsonate (DSMA) for the control of crabgrass, the use of which is purportedly covered by the patent. Pursuant to the trust Vineland and Cleary each were granted non-exclusive licenses under the patent.

The trust arrangement followed litigation between the competitors, Vineland and Cleary, as to ownership and misuse, which resulted in an opinion, later impounded by the Trial Court at the insistence of the litigants, in which it was held that because of their "grossly inequitable conduct" (App. 3a) neither party had enforceable rights in the patent.

Petitioner urged patent misuse on two grounds. First, the trust arrangement placed joint control with veto power of all facets of the exploitation and enforcement of the patent in the hands of the licensee-competitors, and, second, the licensee-competitors by joint action, unlawfully extended the patent monopoly by exacting royalties for the use of two compounds beyond the reach of the patent.

The Trial Court held, and the Court of Appeals affirmed the holding, that there was no patent misuse because the arrangement was in settlement of conflicting claims as to ownership and there was no showing of any exercise of the power to control the exploitation and enforcement of the patent, and no unlawful extension of the patent monopoly.

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REASONS FOR GRANTING THE WRIT

Seven years ago, in a group of cases including *Graham* v. *John Deere,* 383 U.S. 1, this Court exercised its supervisory power to eliminate conflicts and uncertainties in the application of standards of patentability (35 U.S.C. § 103). The stabilizing effect of this Court's *Graham* has been of enormous benefit to the patent system and to the public as well.

We suggest that there is great need that this Court accept jurisdiction and exercise its supervisory power to resolve similar uncertainties and conflicts which have developed as to the meaning of § 112 of the Patent Act of 1952. This portion of the Act, which sets forth the requirements to be satisfied by the inventor in disclosing his invention to the public and defining the metes and bounds of the limited monopoly afforded to the inventor in exchange for his disclosure, has never been before this Court. The restraints imposed by this Court in *Graver* and *General Electric* against overbroad or indefinite monopoly must be revitalized.

Unless the trend evidenced by the decisions of the Sixth and Ninth Circuits is arrested a patentee will be encouraged to overclaim since he may do so with impunity. He may claim subject matter in the public domain, or which is inoperative or useless, and then when the overclaiming is exposed, retreat to the examples disclosed in the specification.

1. An Interpretation by This Court of § 112 of the Patent Act of 1952 is Essential to Resolve the Conflict Between The Circuits.

The first two paragraphs of § 112, requiring that the patent specification contain a "clear, concise and exact" description of the invention concluding with "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention", have been included in the patent statutes in substantially their present form for over one hundred years.

The third paragraph of § 112, referring to functional combination means claims was first included in the patent statutes in the Patent Act of 1952, and has not been construed by this Court.

The principles set out in the first two paragraphs of § 112 were applied by this Court in *Graver, Gen. Electric* and *Corona, supra.* In *Graver,* rendered in 1949 during the period of gestation of the Patent Act of 1952, this Court held that claims unselectively covering "silicates" and "metal silicates" including many inoperative silicates could not be saved from invalidity by limiting the claims to the operative silicates disclosed in the specification, stating (366 U.S. 271, 277):

> "The statute makes provision for specification separately from the claims and requires that the latter 'shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.'
>
> * * *
>
> We have frequently held that *it is the claim which measures the grant to the patentee* [citations omitted]. While the cases more often have dealt with efforts to resort to specifications to expand *claims,* it is clear that the latter *fail equally to perform their function as a measure of the grant when they overclaim the invention.* When they do so to the point of invalidity and are free from ambiguity

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which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. Cf. General Electric Co. v. Wabash Co., 304 U.S. 364, 373-374." (Emphasis added)

The rationale of the rule that overclaiming invalidates the patent is clear.

The "object of . . . (the claims) . . . is not only to secure to (the patentee) all to which he is entitled but to apprise the public of what is still open to them." *McClain* v. *Ortmayer,* 141 U.S. 419, 424 (1891). Unless the claims perform this statutory function there will be created "a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement" which "would discourage invention only little less than unequivocal foreclosure of the field." *United Carbon Co.* v. *Binney & Smith,* 317 U.S. 228, 236 (1942).

The Court of Appeals for the Sixth Circuit in the opinion below and the Court of Appeals for the Ninth Circuit in *Kockum* are of the view that these principles, although expressly continued in § 112, second paragraph, are modified or eliminated altogether by § 112, third paragraph. By restating or limiting a claim, however broad, to cover only embodiments specifically disclosed in the specification, these courts have used § 112, third paragraph, as a vehicle to destroy the essential function of patent claims in setting the metes and bounds of patent monopoly. Uncertain and unpredictable judicial restatement of the claims, not the claims themselves, will now measure the patent grant if these court's mistaken construction of the Patent Act of 1952 is permitted to persist.*

* The impact of and relationship between *Kockum* and this case have already been noticed by the Patent Bar. The BNA Patent, Trademark, Copyright Journal, No. 110, dated 1/11/73, page 7-A

In reaching these results these courts have ignored the directly contrary views of other appellate courts discussed at pages 7-9, *supra*.

The Court below also ignored the legislative history of the Patent Act which reveals no intent to modify the rule of *Graver*. On the contrary, it is abundantly clear that § 112, third paragraph, was enacted to resolve uncertainties which were felt to exist by reason of the Court's opinion in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1, (1946), in which a combination claim defining the invention in terms of "function at the point of claimed inventiveness" was held invalid.

As stated in the Commentary on the Act:

> "It is unquestionable that some measure of greater liberality in the use of functional expressions in combination claims is authorized than had been permitted by some court decisions, and that decisions such as that in Halliburton Oil Well Cementing Co. v. Walker . . . are modified or rendered obsolete, but the exact limits of the enlargement remain to be determined." Pg. 25, Title 35 U.S.C.A. Patents, § 1-110.

While permitting greater liberality in the *use* and *form* of functional combination claims, the statute at

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and 8, reporting the petition for certiorari in Kockum, No. 72-951, states that the Ninth Circuit's decision "allows 'language within the specification to limit and accordingly cure a claim stated in functional terms'," and ends with the following:

> "PTCJ COMMENT: Another case recognizing the 'curative' power of the third paragraph of § 112 is Noll v. O. M. Scott & Sons Co., 467 F.2d 295, 175 USPQ 392 (CA6 1972), PTCJ No. 97, A-2, in which claims that *literally encompassed inoperative compounds* were construed to cover only the compounds described in the specification and their operative equivalents." (emphasis added).

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the same time prescribed a specific limiting rule for construing such claims to prevent the patentee from asserting infringement except on the basis of the embodiments disclosed in the specification and their equivalents.

This purpose is revealed by the Commentary on the Act which states that the third paragraph of § 112:

> "relates primarily to the construction of such claims for the purpose of determining when the claim is infringed (note the use of the word 'cover') and would not appear to have much, if any, applicability in determining the patentability of such claims over the prior art, that is, the Patent Office is not authorized to allow a claim which reads on the prior art." Pg. 26, Title 35 U.S.C.A. § 1-110.

This position, that the language of § 112, par. 3, is for the protection of the public, not a shelter for an overreaching patentee, has been adopted by other courts. *Bryan* v. *S. W. Richardson, Inc.*, 254 F.2d 191 (5th Cir. 1958); *Stearns* v. *Tinker & Rasor*, 252 F.2d 589 (9th Cir. 1957); *Technicon Instrument Corp.* v. *Coleman Instrument*, 255 F. Supp. 630 (D.C. Ill. 1966) Aff'd. 385 F.2d 391 (CA 7, 1967); *Wolowitz* v. *Gulf Oil Co.*, 255 F. Supp. 100 (D.C.D.C. 1966), aff'd. 379 F.2d 452 (CA D.C. 1967). These cases applied paragraph 3, § 112 to limit the scope of functional combination claims in response to the plea of one accused of infringement that the claim was being too broadly construed against it. They did not apply the statute at the demand of the patentee that his overbroad claim be limited to save it from invalidity as did the Sixth and Ninth Circuits.

Thus, the decisions of the Courts of Appeals present three views as to the effect of § 112, third paragraph. Some courts, while recognizing the propriety of func-

tional combination claims, have held that the statute does not change the long-standing tests of overclaiming and patent validity set forth in *Graver*. Other courts, without reaching the question of effect of the statute on the question of patent validity, have applied the statute in the resolution of questions of infringement of functional combination claims.

The Sixth and Ninth Circuits have held that such claims are exempt from the *Graver* rule against overclaiming, and further have construed the scope of statute so broadly as to extend the exemption to substantially all claims.

Clearly a resolution by this Court of these varying views is urgently needed.

2. There is Need for This Court to Resolve the Uncertainties as to Patent Scope Created by the Decisions of the Sixth and Third Circuits.

The action of the Sixth Circuit and the Third Circuit in *Devex, supra,* in limiting the claim to avoid invalidity and refusing to limit it for infringement illustrates the vice of the courts' departure from the rule that the "claim measures the patent grant."

The Court below (citing 35 U.S.C. § 112) held that to avoid invalidity:

> "The statute . . . requires this claim to 'be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof'." (App. 8a)

Yet the Court (also citing 35 U.S.C. § 112) held that for purposes of collecting royalties from the public, respondents were entitled to interpret the claims broadly, stating:

> "Further the claimed subject matter of the Schwerdle patent is not limited to the specifically

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> disclosed embodiments thereof. Broad claims may include subject matter not so embraced." (App. 14a)

The same broad interpretation was accorded the claim to support the holding of infringement. The Trial Court specifically held that the method of use of petitioner's product CLOUT was not the method disclosed in the patent in suit. (App. 9a-11a). Yet infringement was found.

We submit that not only is this ruling wrong, but it points out the inherent vice in the Sixth Circuit's interpretation of § 112. For it puts competitors and members of the public at the mercy of the overclaimer even after litigation exposing the overclaiming.

In *Devex,* supra, the Third Circuit found infringement although there was no proof that the accused process possessed the features which formed the sole basis for the earlier finding of patent validity.

The treatment by these courts of a claim in accordion fashion, contractable for validity and expansible for infringement demands immediate and decisive correction by this Court.

3. The Sixth Circuit's Decision on the Misuse Issues Should be Reviewed, to Prevent Erosion of the Rule that the Existence of Power to Restrain Through Concert of Action Is Per Se Misuse of Patents.

Under terms of the trust agreement (App. 21a, 22a) between the Vineland group and the Cleary group, Vineland and Cleary had complete control of the patent, its exploitation and enforcement, the "trustees," (who were the respective counsel for the two groups)

having no duties other than "ministerial" (App. 21a). The joint power and control given to the Vineland and Cleary groups included (App. 21a, 22a): (a) the fixing of the royalty rate to be paid by third parties; (b) the "direct" supervision and control of the grant of licenses and collection of royalties; (c) prohibition against use of anything other than Standard Formulator License Forms agreed upon between Vineland and Cleary (which permitted sale only in "final retail form") any changes to be subject to mutual agreement by Vineland and Cleary; (d) joint agreement as to notices of infringement, the bringing of infringement suits and selection of counsel in such suits; (e) the maintenance of a joint litigation fund; (f) the placing of the matter of seeking licenses and policing the patent directly in the hands of Vineland and Cleary, with the trustees being *prohibited* from performing these functions.

The Court of Appeals apparently accepted petitioner's proof that the licensee-competitors, Vineland and Cleary, had, through a set of private agreements, placed all matters of substance affecting the enforcement and exploitation of the patent in suit under their joint control. Yet the Court of Appeals found unconvincing petitioner's proof of the exercise of this power, and, absent such proof, the Court held petitioner had not made out its case of patent misuse. (App. 12a)

Thus the Court committed error in refusing to follow the great body of authority which holds that the creation and existence of the joint powers of control in licensee-competitors, whether or not the power was exercised condemns the arrangement as patent misuse. *Clapper* v. *Original Tractor Cab Co.*, 165 F. Supp.

565 (S.D. Ind. 1958); *Clapper* v. *Original Tractor Cab Co.*, 270 F.2d 616 (2d Cir. 1959); *Mason City Tent and Awning Co.* v. *Clapper et al*, 144 F. Supp. 754 (W. D. Mo. 1965); *U.S.* v. *Besser Manufacturing Co.*, 96 F. Supp. 304 (E. D. Mich. 1951), Aff'd. 343 U.S. 444 (1952).

Under its double standard of claim construction (limited for validity, broad for infringement) discussed under Question 2 above, the Court of Appeals also rejected petitioner's contention that Vineland and Cleary, acting jointly through the trust, unlawfully extended the patent monopoly by extracting royalties from the public for the use of two compounds (AMA and CPA) which they knew to be beyond the scope of the patent. (App. 15a)

CONCLUSION

We submit that the time is ripe for this Court to resolve the uncertainties which have arisen since 1952 as to the role of the patent claim in defining and limiting the exclusive privilege awarded to inventors.

A refusal by this Court to accept jurisdiction would continue, indeed encourage, misuse and abuse of patent monopolies, and through the continuing uncertainties inevitably have a restrictive or dampening effect on competition.

We respectfully urge that this Court re-affirm the vigor of the rule that the "patent claim measures the

grant" and that if the applicant claims more than he has invented, his patent is invalid.

Respectfully submitted,

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Dated: February 14, 1973